

resembles the mark "1-900-HOT-SEXY," which is registered for "entertainment in the nature of adult-oriented telephone messages, and the distribution of printed materials in association therewith,"² as to be likely to cause confusion, mistake or deception. Registration also has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's services, the term "HOTSEX" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusals to register.

Turning first, in view of the bearing of the strength of applicant's mark on the question of likelihood of confusion, to consideration of the issue of mere descriptiveness, applicant simply states in its initial brief--without any argument in support thereof--that the term "HOTSEX" is suggestive of its services.³ However, in its reply brief, applicant contends that "[a] reasonable definition of what 'HOTSEX' describes" is "a passionate sexual act" and thus, applicant concedes, such term

² Reg. No. 1,904,734, issued on July 11, 1995, which sets forth dates of first use of January 1991.

³ Although, in an attempt to overcome the mere descriptiveness refusal, applicant also offered in such brief to amend the application to the Supplemental Register "if the issue of likelihood of confusion is overcome," the Examining Attorney in his brief correctly points out that the proposed amendment is improper since, under Trademark Rule 2.142(g): "An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under § 6 of the [Trademark] Act of 1946 or upon order of the Commissioner, but a petition to the Commissioner to reopen an application will be

"is descriptive of ... the qualities and characteristics of passionate intercourse." Applicant nevertheless maintains that its "viewing services," which provide its customers with "pictures of passionate intercourse," are "different from providing the substance of passionate intercourse". According to applicant, the term "HOTSEX" is therefore suggestive, rather than merely descriptive, inasmuch as:

Viewing hot sex is not the same as having hot sex. The prior rejections [by the Examining Attorney] pointed to articles in which "hot sex" is used by others in a descriptive sense. But there was no analysis showing how the use of "hot sex" in the articles make hot sex descriptive of the viewing of the hot sex as in the Applicant's services.

The Examining Attorney, however, is of the view that the term "HOTSEX[,] when applied to applicant's services[,] conveys information about a characteristic or feature of the identified services," namely, that applicant provides "sexually excited entertainment rendered through an on-line global computer network." In support thereof, the Examining Attorney relies upon definitions he made of record from Webster's Ninth New Collegiate Dictionary, which in relevant part define "hot" as "**2 ... c** : sexually excited or receptive : LUSTFUL" and "sex" as "**3 a** : sexually motivated phenomenon or behavior **b** : SEXUAL INTERCOURSE". The Examining Attorney also made of record and relies upon various excerpts of articles which he retrieved from his search of the "NEXIS" data base, the most pertinent of which are reproduced below (**emphasis added**):

considered only upon a showing of sufficient cause for consideration

"It's not as if **hot sex** sells [movie] tickets." -- Star Tribune, January 23, 1997;

[She] has met a man named Rodrigo, with whom she instantly shared a single bout of **hot sex**" -- Atlanta Journal and Constitution, December 29, 1996;

"There's not much more to this film than cars, girls, and **hot sex** between girls in cars" -- Village Voice: Film Supplement, November 19, 1996;

"And the scenes implying **hot sex** between the grandfatherly-looking J.R. and his niece (Tracey Scoggins) are creepy." -- Indianapolis Star, November 15, 1996; and

"Shaughnessy and Ross played father and daughter in 'Days of Our Lives.' Now they're sharing **hot sex** scenes on the tube." -- Chicago Sun-Times, October 14, 1996.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which

of any matter not already adjudicated."

it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

In the present case, we agree with the Examining Attorney that, when applied to applicant's entertainment services of providing adult entertainment services and information regarding adult entertainment solely through an on-line global computer network, the term "HOTSEX" immediately describes, without conjecture or speculation, a significant feature or characteristic of applicant's services, namely, that the subject matter thereof is the depiction of and information about hot sex. Such term merely describes the content of applicant's vicariously provided services. Nothing in the term "HOTSEX," when viewed in the context of applicant's services, requires that its customers utilize imagination, cogitation or mental processing, or gather further information, in order to perceive readily and precisely the descriptive significance thereof as applied to adult entertainment.

Turning, therefore, to the issue of likelihood of confusion, we concur with the Examining Attorney that, notwithstanding the mere descriptiveness of applicant's "HOTSEX" mark and the high degree of suggestiveness inherent in

registrant's "1-900-HOT-SEXY" mark, such marks in their entirety are so similar in sound, appearance, connotation and commercial impression that, if used in connection with the same or closely related services, confusion as to source or sponsorship would be likely. While applicant concedes that the "1-900-" prefix in registrant's mark "stands for a telephone number" and that customers for registrant's services will so understand such "as descriptive of the means over which the service is provided," applicant argues that because its mark lacks any indicia of being a telephone number, it is not likely to cause confusion with registrant's mark.

We agree with the Examining Attorney, however, that "the dominant and most significant feature" of registrant's mark is the "HOT-SEXY" portion inasmuch as consumers "would not view the telephone no. [prefix] 1-900 as having any source indicating capacity". As the Examining Attorney persuasively points out, "[w]ith the large volume of usages of the telephone no. [prefix] 1-900, consumers who encounter them are likely to ... [ascribe] little significance or weight to such designation as a source indicator when applied to the services involved" and are instead "likely to believe that HOT-SEXY in registrant's mark is the source indicator." Instead, they will ascribe the presence of the telephone number prefix in registrant's mark as indicating that the services involve telephone messages rather than regarding it as distinguishing the respective marks based on such prefix. Thus, when considered in their entirety, applicant's

"HOTSEX" mark is substantially similar to registrant's "1-900-HOT-SEXY" mark.

Nevertheless, applicant argues that, due to differences in both the nature of applicant's and registrant's respective adult-oriented entertainment services and the manner in which they are provided, confusion as to the origin or affiliation thereof is not likely to occur. Among other things, applicant maintains that its services "are visual only" while those offered by registrant "are audio only"; that "customers can casually call the [registrant's] 1-900 number, while care is required in the form of registration and verification of age for users of the ... applicant's services"; and that the methods of "payment for the two services are quite different" in that "[t]he on-line user will pay the entertainment provider directly" while the fee for registrant's services appears on and is paid for as part of the customer's monthly telephone bill. We find, however, that the differences asserted by applicant simply are not meaningful distinctions which would preclude a likelihood of confusion.⁴ The services at issue are instead so closely related that consumers would assume, due to the substantial similarity between the respective marks, that the same source provides or sponsors both.

It is well settled, as the Examining Attorney properly notes in this regard, that services need not be identical or even competitive in nature in order to support a finding of likelihood

of confusion. Instead, it is sufficient that the services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978); and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). Here, as the Examining Attorney accurately observes:

Both [services] feature access to the adult entertainment industry. The only differences are the means in which the access is provided. Applicant provides information through an on-line global computer network whereas registrant offers adult-oriented messages by means of the telephone. Thus, it is highly likely that the same consumers would encounter the services involved herein under similar marketing conditions which would cause them to believe that they come from the same source.

Furthermore, as the Examining Attorney maintains, the differences in the payment methods, access means and content formats are merely ancillary or "auxiliary" to the primary purpose of obtaining the desired sexually-oriented entertainment available from the respective services. The subject matter of both applicant's and registrant's services is essentially the same--adult entertainment. Whether a consumer seeks to listen to

⁴ We note, for instance, that when services of any kind are provided on a global computer network, they are typically delivered over telephone lines through the use of a modem.

or just view the various kinds of adult entertainment services provided, either can be done in private in return for a conveniently made payment of the price charged. Moreover, as the specimens furnished with the application make clear, applicant's services also provide the opportunity for purveyors of adult entertainment, including those who (like respondent) offer adult-oriented telephone messages and distribute printed materials in association therewith,⁵ to advertise their services and goods to those interested in the type of adult entertainment services provided by applicant.⁶ To consumers accustomed to viewing web-site environments which feature such ads, it would not be unreasonable for those who are acquainted with either applicant's "HOTSEX" mark or registrant's "1-900-HOT-SEX" mark to assume, as the Examining Attorney contends, that the same provider or source has expanded its adult entertainment offerings to offer both types of services.

⁵ While it is not unreasonable to assume that others offering various adult-oriented entertainment services would desire to reach the same audience as applicant's customers and would therefore be likely to advertise their services on its "HOTSEX" web-site, we do not mean to suggest that applicant would knowingly foster a likelihood of confusion by allowing registrant to advertise its "1-900-HOT-SEX" services thereon.

⁶ According to applicant's specimens, "[a]n ad placed on HotSex will be seen by people who have the means to purchase your product or service" and that applicant's advertisers "have found that an ad placed with HotSex produces a better response than they are able to get with any comparable ad placed in any conventional print publication." The specimens additionally explain that:

Ads on the World-Wide-Web consist of an image (or text) inserted into a popular site, such as HotSex. Visitors who are interested in the ad "click" on it to follow a link to the advertiser's site where more information is provided.

Finally, while applicant argues that it is unaware of any instances of actual confusion between its mark and registrant's mark, we note that we not know what registrant's experience has been. More importantly, as applicant concedes in its main brief, by the very nature of registrant's services, "people are very discreet about such calling and keep such calling private." Applicant's customers, therefore, are not likely to report incidents of actual confusion. The purported lack of any occurrences of actual confusion is thus not dispositive, given that evidence thereof is notoriously difficult to come by and, as correctly noted by the Examining Attorney, the test under Section 2(d) is in any event likelihood of confusion rather than actual confusion. See, e.g., Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990); Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992); Block Drug Co. v. Den-Mat Inc., 17 USPQ2d 1315, 1318 (TTAB 1989); and Guardian Products Co., Inc. v. Scott Paper Co., 200 USPQ 738, 742 (TTAB 1978).

Decision: The refusals under Section 2(d) and Section 2(e)(1) are affirmed.

R. F. Cissel

E. J. Seeherman

G. D. Hohein
Administrative Trademark Judges,

Ser. No. 75/163,283

Trademark Trial and Appeal Board